

## **REMARKS**

### **I. Status and Disposition of the Claims**

Claims 1-140 are pending. Claims 16, 17, 19-25, 31, 32, 40, 45-69, 71-76, 102-109, and 111-113 are withdrawn from consideration by the Examiner as being drawn to a nonelected species. See Office Action, pages 2-3. Claims 1, 129-131, and 137 are amended herein.

Support for the above amendments may be found in the as-filed specification and claims, for example, in original claims 1, 129-131, and 137. Accordingly, these amendments raise no issue of new matter.

### **II. Response to Claim Rejections**

In the Office Action, the Examiner:

- rejects claim 137 under 35 U.S.C. § 112 (*see id.* at 3-4);
- rejects claims 1-9, 14-15, 26-29, 37-38, 79, 86-89, 91-98, 102, and 114 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,032,628 ("Papantoniou") (*see id.* at 4-5);
- rejects claims 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, 114-140 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,410,005 ("Galleguillos") (*see id.* at 7-10); and
- rejects the claims under the doctrine of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-121 of co-pending U.S. Application No. 10/670,478 (*see id.* at 10-11).

In response, Applicants respectfully submit the following remarks.

#### **A. 35 U.S.C. § 112, second paragraph rejection of claim 137**

The Examiner rejects claim 137 under 35 U.S.C. § 112, second paragraph, because the phrase "such as" allegedly renders the claim indefinite. Office Action at 3. Applicants have amended claim 137, without prejudice or disclaimer, to remove the

phrase in conformance with U.S. claim drafting practice. In view of this amendment, Applicants submit that the 35 U.S.C. § 112, second paragraph rejection is moot and respectfully request its withdrawal.

**B. 35 U.S.C. § 102(b) Rejection**

The Examiner rejects claims 1-9, 14-15, 26-29, 37-38, 79, 86-89, 91-98, 102, and 114 under 35 U.S.C. § 102(b) as allegedly anticipated by Papantoniou for the reasons set forth at pages 4 and 5 of the Office Action. In making this rejection, the Examiner alleges that Papantoniou “discloses the same claimed components as the instant claims; therefore, it would inherently possess the same functional limitations as the instant claims.” *Id.* at 5. The Examiner also alleges that the phrase “capable of” delineates an optional limitation and, therefore, the functional limitation is not required. *Id.* Applicants respectfully disagree with and traverse this rejection for at least the following reasons.

It has long been held that to establish anticipation under 35 U.S.C. §102(b), an examiner must establish that a reference teaches, either expressly or inherently, each and every element of a claim. *See* M.P.E.P. § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Further, a rejection under § 102 is proper **only** when the claimed subject matter is **identically** described or disclosed in the prior art. *See In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). As discussed below, the Examiner has failed to meet this burden in the present case.

The Examiner has not established that Papantoniou teaches or even suggests a composition having each and every feature of the present claims. Papantoniou discloses emulsions that are suitable for use in cosmetics, and which comprise a block

copolymer comprising at least one lipophilic sequence and at least one hydrophilic sequence. See Papantoniou, column 2, lines 10-20. The lipophilic sequences of the polymer may be chosen from lipophilic chain monomers, and the hydrophilic sequences are obtained from monomers having hydrophilic chains. *Id.* at 20-25. The general chemical structure of the lipophilic monomers is shown at column 2, line 25-column 4, line 7. Papantoniou also discloses a plethora of examples of hydrophilic monomers at column 4, lines 8-18.

Papantoniou, however, does not disclose an at least one additional monomer chosen from acrylic acid, methacrylic acid, and trifluoroethyl methacrylate, let alone a block polymer comprising the at least one additional monomer as in the presently elected species under examination. See Response to Office Communication filed October 9, 2007; Requirement for Election of Species dated March 30, 2007. For at least this reason, Applicants respectfully submit that Papantoniou does not anticipate at least the presently elected species.

In addition, the Examiner has not established that Papantoniou discloses a composition that forms a film having the claimed dampening power. The Examiner asserts that this property is inherently possessed by Papantoniou's compositions. See Office Action at page 5. However, "[t]he fact that a certain result or characteristic **may** occur or be present in the prior art is **not** sufficient to establish the inherency of that result or characteristic. . . . To establish inherency, [the] extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference." See M.P.E.P. § 2112 (IV) (citations omitted, emphasis added). Further, when relying on a theory of inherency, the examiner **must** provide a basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *See id.*

In the present case, the Examiner has not set forth any evidence in support of this conclusory statement. Rather, the Examiner merely states that "Papantoniou discloses the same claimed components as the instant claims; therefore, it would inherently possess the same functional limitations as the instant claims." Office Action at 4. Such a statement does **not** amount to the required basis in fact and/or technical reasoning, but rather conjecture predicated on the implicit (and incorrect) assumption that all compositions comprising block polymers formed from similar starting materials form films having the same (or at least the claimed) dampening power. This is simply not the case. Many variables, including the particular block polymers and other components of a composition, affect the properties of a film resulting from such a composition. Thus, Applicants respectfully submit that the Examiner has not established that the claimed dampening power is inherent to the compositions of Papantoniou, and therefore, all the elements of the present invention are not disclosed in that reference.

Applicants also disagree with the Examiner's position that the phrase "capable of" delineates an optional limitation. *See* Office Action at page 5. Nonetheless, to advance prosecution, and without prejudice or disclaimer, Applicants have amended the independent claims to recite that the composition "forms" a film "having" the claimed dampening power. *See, e.g.,* presently amended claim 1.

For at least the foregoing reasons, Applicants submit that the claims are not anticipated by Papantoniou and respectfully request withdrawal of the rejection.

**C. § 103(a) rejection over Papantoniou**

The Examiner rejects claims 34-36, 42-44, 99-101, 115-117, and 131-140 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Papantoniou for the reasons set forth at pages 6 and 7 of the Office Action. In making this rejection, the Examiner concedes that Papantoniou does not disclose the claimed packaging configuration or the specific amount of each block in the claimed block polymer. Office Action, pages 6 and 7. Nonetheless, the Examiner asserts that one of ordinary skill in the art would have been “motivated to package a composition in a kit” as claimed, because such kits are “convenient.” *Id.* at 7. The Examiner further alleges that “[w]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *Id.* at 6 (citation omitted). Applicants respectfully disagree for at least the following reasons.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

The Supreme Court in *KSR* also held that “[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis.” M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this to mean that when applicable, as here, TSM reasoning may still be applied not only by the Office, but also by Applicant to refute a §103 rejection.

In the present case, Applicants respectfully traverse this rejection for at least the same reasons discussed above in section II(B). That is, assuming *arguendo* that the Examiner’s assertions with respect to the claimed kit and amounts are considered to be true (which applicants do not concede), the Examiner still has not established that Papantoniou teaches or even suggests a composition comprising a block polymer within the purview of the present claims (much less the elected species), and which forms a film having the claimed dampening power.

In addition, Applicants respectfully submit that the Examiner has not provided any tenable rationale establishing why one of ordinary skill in the art would modify Papantoniou’s compositions so as to obtain the claimed composition. Nor has the Examiner pointed to evidence in the prior art establishing why it would have been obvious to one of ordinary skill in the art to package a composition within the purview of the present claims. The Examiner is legally required to provide such evidence. Thus the rejection is improper and, for this additional reason, should be withdrawn.

**D. § 103(a) Rejection over Galleguillos**

The Examiner rejects claims 1-15, 18, 26-30, 33-39, 41-44, 70, 77-102, 110, 114-140 under 35 U.S.C. § 103(a) as being unpatentable over Galleguillos for the

reasons set forth at pages 7-10 of the Office Action. In making this rejection, the Examiner alleges that “one skilled in the art would have readily envisaged the selection of suitable monomers having Tg differences as taught, motivated by the reasonable expectation of success in forming block copolymers with balanced hydrophilic/hydrophobic characteristics.” Office Action at 9. In addition, the Examiner alleges that Galleguillos would inherently possess the claimed properties, based on its alleged disclosure of a block copolymer comprising component monomers that are similar to the claimed monomers. *See id.* at 10. Applicants respectfully disagree and traverse this rejection for at least the following reasons.

As set forth below, Galleguillos does not teach or suggest a composition comprising a block polymer having the specifically claimed combination of first block monomer, second block monomer, and additional monomer of the elected species. In addition, Galleguillos fails to teach or even suggest a composition that forms a film having the claimed dampening power.

Moreover, Applicants note that the Examiner asserts that it would have been obvious to one of ordinary skill to a) select “suitable monomers having Tg differences as taught, motivated by the reasonable expectation of success in forming block copolymers with balanced hydrophilic/hydrophobic characteristics[;]” and b) “control the optimum molecular weight, polydispersity, polymer composition, and architectures of the resultant block copolymer product by varying experimental parameters such as source, amount, and solvation of catalyst. . . etc.” *See* Office Action at page 9. However, these statements are completely unsupported by evidence. Thus, the Examiner has not established a *prima facie* case of obviousness, as detailed below.

Galleguillos does not teach or even suggest a composition comprising a block polymer comprising the specifically claimed combination of first block monomer, second block monomer, and additional monomer of the elected species. More particularly, Galleguillos discloses methods for preparing a wide variety of AB block copolymers having a three-dimensional branched and blocky structure. *See id.* at column 6, lines 10-17; column 7, lines 1-5; column 4, lines 45-67. However, Galleguillos does not disclose the claimed combination of monomers. Even if Galleguillos did disclose the claimed combination of monomers, it does not disclose combining those monomers to obtain the claimed properties.

Furthermore, the Examiner has not explained, or even attempted to explain, why one of ordinary skill in the art would select the specifically claimed monomers out of almost limitless number of exemplary monomers disclosed by Galleguillos. Applicants respectfully submit that the Examiner is impermissibly using the present specification as a guide to selectively pick and choose the portions of Galleguillos that are necessary to arrive at the present invention, while ignoring the disclosure of the reference as a whole. Such practice has long been held to be improper. *See In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965)(holding that “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.”); *M.P.E.P.* § 2141(II) (citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 (Fed. Cir. 1986) and indicating that the use of hindsight reasoning to establish obviousness under § 103 is improper).



Galleguillos also indicates that the composition of the disclosed copolymer can be controlled to obtain "selected properties," but nothing in the reference indicates that the claimed properties of the inventive composition (e.g., the claimed dampening power) are desired. Moreover, nothing in the reference provides an indication as to what controls are necessary to achieve the claimed properties, much less why they are beneficial. *See id.* at column 12, lines 12-15.

Finally, for the reasons set forth above, Applicants disagree with the Examiner's assertion that the copolymers of Galleguillos would "inherently possess the same functional limitations as the instant claims" because it "discloses the same claimed components as the instant claims." Office Action, page 10. That is, the Examiner has not provided any basis in fact and/or technical reasoning in support of the position that Galleguillos' copolymer compositions possess the claimed properties, e.g., the claimed dampening power. Rather, the Examiner's position is based on a blanket and uncorroborated assertion that "Galleguillos discloses the same claimed components as the instant claims." As discussed above, however, Galleguillos does not disclose a specific composition comprising a copolymer within the purview of the present claims. Indeed, as also discussed above, Galleguillos's broad teachings would not even direct one of skill in the art to the claimed block polymers, let alone the compositions.

For at least the foregoing reasons, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness and the rejection should be withdrawn.

**E. Double Patenting Rejection**

Finally, the Examiner rejects the claims under the doctrine of non-statutory obviousness-type double patenting as being unpatentable over claims 1-121 of co-pending U.S. Application No. 10/670,478. Because this rejection is provisional, Applicants respectfully request that the Examiner hold this rejection in abeyance until there is an indication of allowable subject matter in this application.

**III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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